

**REMARKS**

Claims 1-41 were pending. Claims 1-4, 6-23, 25-34, and 36-41 stand rejected and claims 5, 24, and 35 stand objected to. By virtue of this response, claims 1, 5, 14, 20, 24, 31, and 35 have been amended, and new claims 42 and 43 have been added. The amendment to the claims and new claims are fully supported by the claims as originally presented and no new matter has been added. Accordingly, claims 1-43 are currently under consideration.

For the Examiner's convenience, Applicants' remarks are presented in the same order in which they were raised in the Office Action.

**Claim Rejections under 35 USC §103**

A. Claims 1-4, 11-13, 14-15, 19, 20-23, 30, 31-34, 36, and 41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Basham et al. (U.S. Patent No. 6,779,080) in view of Takayama (U.S. Patent No. 6,301,067).

Applicants have amended independent claim 1 to recite that the method includes "allowing write operations to the storage medium after previously written data, the write operations overwriting a previous EOD marker associated with the previously written data, and preventing write operations to the storage medium prior to the previous EOD marker." Independent claims 14, 20, and 31 have been amended similarly to claim 1.

Applicants respectfully submit that the combination of Basham and Takayama fails to provide a *prima facie* case of obviousness because 1) the combination fails to disclose or suggest every feature of the independent claims, 2) the modifications to Basham to meet the features of the present claims would impermissibly alter the principle of operation of Basham, and 3) there is no teaching, suggestion or motivation to combine and modify the references to meet the features of the present claims.

First, the Examiner states that Basham discloses "allowing write operation to the storage medium after previously written data, and preventing write operations prior to an EOD marker (see

figs. 1-2,5 and col.1, lines 36-55; col.7, lines 34-col.8, line 5).” Applicants disagree and submit that Basham does not disclose or suggest “preventing write operations to the storage medium prior to a previous EOD marker,” let alone “overwriting a previous EOD marker associated with the previously written data,” as recited by claim 1. In contrast to the recited features, Basham clearly discloses that the write operation of the system and method disclosed therein is based on a “write append limiter sequentially identifying a location on the data storage medium before which data is not permitted to be altered.” (Basham, Col. 2, lines 30-33) For example, Basham uses a “write append limiter” and “write allowance index” stored with each cartridge to determine if a location for writing is permitted. (Basham, Col. 8, lines 18-52). Accordingly, the use of a “write append limiter” and “write allowance index” does not disclose or suggest the features of “preventing write operations ... prior to an EOD marker,” and overwriting the previous EOD marker as recited by claim 1 (and similarly recited by independent claims 14, 20, and 31).

Additionally, the alleged disclosure of Takayama of writing an EOD marker associated with the end of data does not cure the deficiencies of Basham. Specifically, such disclosure (e.g., merely writing an EOD marker) fails to teach or suggest “preventing write operations to the storage medium prior to an EOD marker,” or “overwriting a previous EOD marker,” as recited. In particular, Basham still relies on the write append limiter for identifying a location before which data is not permitted to be overwritten, and not an EOD marker. Furthermore, Takayama does not disclose or suggest overwriting a previous EOD marker as recited by claim 1. Therefore, the combination of Basham and Takayama fails to meet the features of the present claims and the rejection must be withdrawn.

Second, the proposed modification Basham to meet the features of the present claims (i.e., to prevent write operations prior to an EOD marker) would inappropriately and impermissibly alter the principle of operation of Basham. (MPEP § 2143.01, i.e., “The proposed modification cannot change the principle of operation of a reference,”) In this instance, Basham clearly describes the principle of operation thereof as the use of a “write append limiter” and “write allowance index” stored with the cartridge for identifying a location on the storage medium before which data is not permitted to be altered. (Basham, Col. 2, lines 30-33; col. 12, lines 49-51.) Accordingly, modifying

Basham to prevent a write append operation prior to a located or detected EOD marker would impermissibly alter the principle of operation of Basham. The rejection therefore must be withdrawn because the modifications to Basham, whether in combination with Takayama or otherwise, to prevent writing prior to an EOD marker would impermissibly change the principle of operation of Basham.

Third, the motivation (e.g., “to provide an indication of the end of the previously written data, thus prevent overwriting the original data prior to this point”) provided in the Office Action for combining Basham with Takayama is lacking. First, Basham describes a solution for preventing overwriting previously written data that does not rely on an EOD marker. Second, Basham discusses “virtual WORM” technology and specifically mentions EOD markers in the background section thereof (Col. 1, lines 38-58) as a “technical limitation,” namely that “[w]rite append operations are not possible because certain end-of-data metadata is always written after the data is laid down on the tape. The end-of-data metadata includes trailer labels, file marks, EOD markers, and other metadata that signals the end of data.” (Basham, col. 1, lines 47-52.) Thus, the EOD marker providing an indication of the end of the previously written data fails to provide a suggestion or motivation to modify Basham to meet the features of claim 1.

Accordingly, for at least the above stated reasons, the combination of references fails to render the independent claims (1, 14, 20, and 31) obvious and the rejection must be withdrawn. Additionally, all claims depending from claims 1, 14, 20, and 31 should be allowed for at least similar reasons.

B. Claims 6-10, 16-18, 25-29, and 36-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Basham et al. (U.S. Patent No. 6,779,080) in view of Takayama (U.S. Patent No. 6,301,067), further in view of Christie, Jr. (U.S. Patent No. 6,947,237).

Claims 6-10, 16-18, 25-29, and 36-40 depend from claims 1, 14, 20, and 31 respectively and are allowable over Basham in view of Takayama for at least similar reasons as claims 1, 14, 20, and 31 discussed herein. The addition of Christi, Jr. fails to cure the deficiencies of the combination

of Basham and Takayama identified above. Accordingly, the rejection should be withdrawn and the claims allowed.

### **Allowable Subject Matter**

Claims 5, 24, 35 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants thank the Examiner for the indication of allowable subject matter; however, in light of the amendments and remarks presented herein Applicants believe that all claims are in condition for immediate allowance.

### **New Claims**

New claims 42 and 43 have been added. Applicants submit that claim 42 is allowable over Basham and Takayama for at least similar reasons as claims 1, 14, 20, and 31 discussed above. Additionally, claim 42 includes the features of “forwarding to an EOD marker” if the storage medium is overwrite protected. Such a feature is not disclosed or suggested by the combination of Basham and Takayama at least because Basham relies on the “write append limiter” and “write allowance index” stored with the cartridge for identifying a location on the storage medium before which data is not permitted to be altered, and not an EOD marker. (Basham, Col. 2, lines 30-33; col. 12, lines 49-51.) Therefore, the feature of “forwarding to an EOD maker” is not disclosed or suggested by the combination.

**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 249212027600. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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